

REMARKS

Claims 17 and 20–36 are pending.

CLAIM AMENDMENTS

Claim 17 is amended to speed up prosecution and without prejudice or disclaimer of the subject matter claimed therein. No new matter is added in the amendment to claim 17. Applicants reserve the right to pursue any cancelled subject matter in a future continuation application. The amendment to claim 17 is supported by the specification at, for example, page 14, lines 18-20 and page 19, lines 3-6.

OATH/DECLARATION

The Examiner maintains that the present application claims subject matter not originally claimed or embraced in the statement of the invention and requires a new oath/declaration. Applicants disagree but respectfully submit that, because of the amendment to claim 17, a new oath/declaration is not required.

PRIORITY

Applicants' claim of priority of U. S. Serial Nos. 08/533,942, 09/031,572 and 09/426,325 stands denied. The Examiner maintains that the specifications

of these prior applications provide no implicit or explicit support for a combination comprising a generic catheter and a gene encoding p21.

Again, applicants disagree. Applicants previously addressed this issue in their Appeal Brief, filed on March 22, 2005 and incorporate the arguments made there into the present response. Applicants also respectfully submit that the Examiner's objection is moot because of the amendment to claim 17. The combination of a double-balloon catheter and a nucleic acid encoding p21 is disclosed in the specifications of the priority applications, including at the following places: U.S. Patent No. 5,863,904 ("the '904 patent") (U. S. Serial No. 08/533,942) at column 6, lines 51-53 and column 8, lines 36-38; in U.S. Patent No. 6,057,300 (U. S. Serial No. 09/031,572) at column 6, lines 49-51 and column 8, lines 36-38; in U.S. Patent No. 6,218,372 (U. S. Serial No. 09/426,325) at column 6, lines 49-51 and column 8, lines 55-58; as well as in the present application at page 14, lines 18-20 and page 19, lines 3-6.

Because Applicant's original parent application and all of the applications in the priority chain support and disclose a nucleic acid encoding p21 in combination with a double-balloon catheter, the denial of priority should be withdrawn.

35 U.S.C. §112, FIRST PARAGRAPH REJECTIONS

Claims 17 and 19-36 are rejected under 35 U.S.C. §112, first paragraph, for allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicants respectfully submit that the rejection is moot in view of the amendment to claim 17 and request that the rejection be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 17 and 19–36 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Nabel *et al.* (U.S. Patent Number 5,863,904) (“the ‘904 patent”). Applicants respectfully traverse the Examiner’s rejection. In view of the arguments made above with respect to the priority of the instant application, Applicants submit that this application is entitled to a priority date of September 26, 1995. Accordingly, the ‘904 patent, which issued on Jan 26, 1999 cannot anticipate the present claims because it was not published more than one year prior to the priority date of the present application. Applicants request that the Examiner withdraw the 35 U.S.C. §102(b) rejection of claims 17 and 20-36.

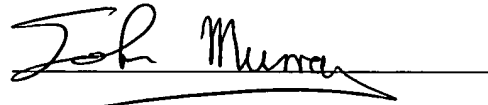
Claims 17, 20-24, 26-27 and 31 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Eastman, *et al.* (1995) Cancer Research 55: pp.5151-55 (“Eastman”). Applicants have incorporated the limitations of claim 19 into claim 17 and submit that the above rejection is moot in view of this amendment. Applicants also note that Eastman lists a publication date of November 15, 1995 which is later than the priority date of the present

application. Applicants request that the Examiner withdraw the 35 U.S.C. §102(b) rejection of claims 17, 20-24, 26-27 and 31.

Applicants have overcome each of the Examiner's rejections. The application is therefore in condition for allowance and early notice to this effect is earnestly solicited. If, for any reason, the Examiner feels that an interview would resolve any remaining issues, he is respectfully requested to contact the undersigned attorney at (312) 321-4229.

Respectfully submitted,

Dated: NOVEMBER 16, 2005

A handwritten signature in dark ink, appearing to read "John Murray", is written over a horizontal line.

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